REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

I.   STATUS OF THE CLAIMS

Claims 1-15 are amended.

New claims 16-20 have been added.

In light of the above, claims 1-20 are pending.

II.   OBJECTION TO THE DRAWINGS, SPECIFICATION AND CLAIMS

On page 2 of the Action Figures 3,4 and 5 were objected to. A letter to the Examiner has been filed with this Amendment requesting approval for changes in the drawings which should overcome the objection. Therefore, withdrawal of the objection is respectfully requested.

Page 2 of the Action further objects to the specification. The specification has been amended to overcome the objections and withdrawal of the objection is respectfully requested.

Pages 2-3 of the Action objects to claims 1 and 2. The claims have been amended to overcome the objection and withdrawal of the objection is respectfully requested.

III.   REJECTION OF CLAIMS 1-10, 12 AND 14 UNDER 35 U.S.C. § 101

On page 3 of the Action claims 1-10, 12 and 14 are rejected under 35 U.S.C. § 101 as being directed to non-statutory matter.

More particularly, the Examiner states that, "claims 1-9 recite a system comprised of non-functional descriptive material per se. The claims merely recite the components and objectives of the system without describing the methods used to

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achieve these objectives. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory."

The Applicant disagrees with the Examiner's characterization of claim 1. First, claim 1 does not claim or relate to a data structure. Additionally, claim 1 does not merely recite objectives of the system but also includes recitations of the method and structure used therein. For example, claim 1 includes features such as, "a user registration/reference means that interfaces with a user of the computer-related products..." and "notifying said user information general management means...at a request of the user..." Such features incorporate structure (a computer) and cannot be classified as "non-functional." As such, dependent claims 2-9 are statutory as well.

The Examiner also states that claims 10,12 and 14 recite "non-specific machines holding computer programs per se and merely manipulate an abstract idea without limitation to any practical application. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some usefulness."

On the contrary, claims 10, 12 and 14 do not merely relate to abstract ideas without limitation to any practical application. Claim 10 relates to a management apparatus which manages user information about a computer-related product. Claims 12 and 14 relate to an apparatus for notifying and requesting product information from an external unit. All three of these claims are clearly directed to a practical application, namely the improved delivery of product information to the user.

Regarding claims 1-15, for more information as to what is currently considered statutory see the recently issued PTO Guidelines for software inventions and State St. Bank & Trust Co. v. Signature Fin. Group, Inc., 927 F.Supp. 502, 38 U.S.P.Q.2d 1530 (D Mass. 1996). The Examiner's re-review of the claims applying the updated standards is respectfully requested.

Therefore, in light of the above remarks, it is respectfully requested that the

rejection of claims 1-10, 12 and 14 is withdrawn.

IV.   REJECTION OF CLAIMS 1-4 AND 10-13 UNDER 35 U.S.C. § 102(e)

On page 4 of the Action, claims 1-4 and 10-13 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hill, U.S. Patent No. 5,761,649 (Hereinafter "Hill").

Hill relates to sending catalog data from a vendor directly to a home user. The customer is asked to enter the telephone number of his vendor's computer and registration data such as his name, address, etc... (Hill, col. 10, lines 60-60). The customer's computer then dials the vendor directly, which after verifying the customer's entered information, responds with recent catalog data, including graphics and text related to selected products.

Claim 1 in part recites, "a user information **general management means** generally managing **user registration information and using status information transmitted from a user of the computer-related product**" (emphasis added).

Hill does not contain a general management unit or equivalent. The transmittal in Hill is sent **directly** between the customer and the vendor. The general management means manages required information relieving such burden from the home user or the vendor.

Hill is directed to updating catalog information and has does not relate to registration information and using status information. "Using status information" is not even mentioned in Hill and has no meaning in the Hill context.

Additionally, claim 1 recites, "the user who uses a computer-related product related to the user registration information and the using status information." The catalog product information as transmitted in Hill has nothing to do with a computer-related product in use.

Claims 2-4 are dependent on claim 1 and for the above reasons, are patentable over the prior art. In addition, these claims contain additional features not disclosed or

taught by the prior art as well.

With regard to claim 2, Hill does not disclose a user information general management unit which works in conjunction with both a home user and a vendor.

With regard to claim 3, Hill does not disclose "a user registration/reference means common to each of a plurality of software products." The catalog updating system in Hill is a stand-alone product and is not common to any other software products. In addition, claim 3 recites, "when any software products is installed by a user, the user registration/reference unit is also installed." Such an automatic installation is beneficial in that the user does not have to be burdened with separately installing a registration unit.

With regard to claim 4, Hill does not disclose a "user information general management means extracts the new information depending on information extraction condition containing a requested information type in the registration information..." Hill does not disclose information extraction conditions.

Claim 10 is also not shown in the prior art. Hill relates to a system in which the data is transmitted directly from the home user to/from the vendor. However, Hill does not disclose an apparatus which contains "a user information general management means for managing using status **provided by the user**," "a product information manage means for managing product information **provided by the vendor**" and "a product information notification means..." (Emphasis added). The apparatus as disclosed in claim 10 is beneficial over a system such as in Hill in that having the data handled by a party other than the home user or the vendor is beneficial in that it allows standardization which simplifies the process for both the home user and the vendor. For example, the home user only has to connect to one site to receive updates, not numerous ones for each vendor.

With regard to claim 11, Hill does not disclose "managing use status information" and "managing product information." As stated in the above remarks, the system as

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disclosed in Hill does not serve to manage this information at all, only to provide a direct link from the user to the vendor. Managing this information is beneficial in that it relieves both the user and the vendor the extra burdens of having to actively participate in the registration process on their own.

With regard to claims 12 and 13, in addition to all of the above remarks, Hill does not relate at all to "using status information."

Therefore, in light of the above remarks, it is respectfully requested that the rejection of claims 1-4 and 10-13 is withdrawn.

V.   REJECTION OF CLAIMS 7-9, 14 AND 15 UNDER 35 U.S.C. § 103(a)

On page 6 of the Action the Examiner rejected claims 7-9, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Hill in view of Peschel, Joe, "Lubricate Your System With Oil Change," Infoworld, v18, n51, p.93 (Hereinafter Peschel).

Peschel relates to a product called "Oil Change," which operates by searching a user's entire hard drive for applications, then downloads updates stored on CyberMedia's update list.

With regards to claim 7, 8 and 9, these claims are dependent upon claim 1 and are patentable for reasons stated in the above remarks. Additionally, Peschel does not relate to "using status information." Each time "Oil Change" is executed, it performs a lengthy search and update process. Additionally, Oil Change operates by searching the users entire hard drive, not by obtaining "user registration information" which identifies which applications are currently installed on the users computer. Using user registration information is beneficial in that searching the entire hard-drive for applications can take a long time, causing "hefty online charges" (Peschel, line 12). Registration information does not exist in the Oil Change system.

With regard to claims 14 and 15, the Oil Change system does not disclose, teach or suggest "user registration information" or "using status information," which are

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superior over the Oil Change system for the reasons stated above. Additionally, Oil Change does not disclose "notifying an external unit of new information about the computer-related product." As stated in the above remarks, Oil Change serves to search the user's entire hard-drive for applications and does not include such a notification service.

Therefore, in light of the foregoing remarks, withdrawal of the rejection of claims 7-9 and 14-15 is respectfully requested.

VI.   REJECTION OF CLAIMS 5 and 6 under 35 U.S.C. § 103(a)

On page 7 of the Action, the Examiner rejects claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Hill.

Claims 5 and 6 are dependent upon claim 1, and for the reasons presented above are patentable over the prior art. In addition, claims 5 and 6 contains additional features not taught or suggested by the prior art.

Claim 5 recites, "the using status information contains the number of times the software product was started." Hill discloses nothing about how many times a software product is started. The Examiner states on page 7 that, "it is well known within the technological art ...[that] a demo is normally able to be used for a limited number of times." The Examiner's reasoning of his rejection is as follows: a software demo is able to be used for a limited period of time; therefore Hill can be modified to request catalog information after predetermined number of uses (even though an update request in Hill has to be affirmatively entered by the user, and even though Hill has nothing to do with software demos); therefore the modified Hill can be again modified to make the present invention as claimed in claims 5,6 and their dependent claim 1 (even though the present invention has nothing to do with software demos or user requested catalog information as in Hill). Here it seems the Examiner is using impermissible hindsight in formulating his rejection.

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Also, it is well known in patent law that there also must be some suggestion in the prior art to combine the references. The Examiner makes no statement where he finds the suggestion to make all these modifications to create the present invention, again which makes it seem like the Examiner is using impermissible hindsight in his rejection.

In light of the foregoing remarks, withdrawal of the rejection of claims 5 and 6 is respectfully requested.

VII.   NEW CLAIMS

New claims 16-20 have been added which recite features similar to those discussed above (and additional features), not recited by the prior art. Therefore, allowance of new claims 16-20 is respectfully requested.

VIII. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

If any further fees are required in connection with the filing of this Amendment, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY

Date: _6/14/99_   By: _____

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CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231

_____, 19_99_

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Date: _June 14, 1999_